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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,289	07/24/2001	Jeffrey J. Norman	0102	5203

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EXAMINER

SINGH, SUNIL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,289

Applicant(s)

NORMAN ET AL.

Examiner

Sunil Singh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-30 is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 13-22 is/are rejected.
- 7) ☒ Claim(s) 3,5-12 and 23-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371⁶ of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3. Claims 1, 13 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Whitfield, Jr. (US 6419421).

Whitfield, Jr. discloses an underground retention apparatus ((11), see Fig. 7) comprising in combination perimeter support means (2) for providing structural support; liner means (3) secured to the perimeter support means for holding a quantity of run off water; means (13) for draining run off water onto the liner; means for draining the run off water from the liner (14); and roof means (5) disposed on the perimeter support means for covering the liner and for providing structural support for appropriate usage of the roof means.

(Re claim 13), the liner means includes an upper side wall portion (this is considered as a top portion of side plate (3)), a lower side wall portion (this is considered as a middle portion of side plate (3)), and a bottom portion (this is considered as the bottom portion of side plate (3)).

(Re claim 16), the liner is made of plastic (see abstract).

Claim Rejections - 35 USC § 102

4. Claims 1, 2, 13-15, 17-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Jordan et al. (US 3950252).

Jordan et al. discloses an underground retention apparatus (20) comprising in combination perimeter support means (90,92) for providing structural support; liner

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means (24, 27-30) secured to the perimeter support means for holding a quantity of run off waste water; means (63) for draining run off waste water onto the liner; means for draining the filtered water from the liner (83); and roof means (94) disposed on the perimeter support means for covering the liner and for providing structural support for appropriate usage of the roof means.

(Re claims 2, 18), the perimeter support means comprises a retaining wall.

(Re claims 13-15), Jordan et al. discloses that the upper side wall portion is disposed at a relatively shallow angle and that the lower side wall portion is disposed at a relatively steep angle (see Fig. 2).

(Re claim 17), the liner is made of cementitious material (see col. 2 line 1)

(Re claim 19), the liner means is secured to the vertically disposed retaining wall.

(Re claim 20), the retaining wall is considered to be relatively short.

(Re claim 21), the retaining wall is considered to be relatively long.

(Re claim 22), the perimeter support means includes a stepped retaining wall (90,92).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

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patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitfield, Jr..

Whitfield, Jr. discloses the invention substantially as claimed. However, Whitfield, Jr. is silent about the liner being made out of cementitious material. The examiner takes official notice that it is well known to make liner/reservoir out of cementitious material. It would have been considered obvious to one ordinary skill in the art to modify Whitfield, Jr. by making his liner out of cement since such material is known to be used to make liners in order to have liner/reservoir that would not be subject to rust. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan et al. in view of Bohnhoff (US 6095718).

Jordan et al. discloses the invention substantially as claimed. However, Jordan et al. lacks having a pump to drain the filtered water from the liner. Bohnhoff teaches having a pump (34) to drain water from a reservoir. It would have been considered obvious to one of ordinary skill in the art to modify Jordan et al. to include a pump as

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taught by Bohnhoff in order to facilitate the transport of the filtered water to a desired location.

Allowable Subject Matter

8. Claims 3, 5-12 and 23-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 27-30 are allowed.

10. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

11. Applicant's arguments filed 6/24/03 have been fully considered but they are not persuasive. Applicant argues that Whitfield teaches a very small plastic basin with a 3" diameter input hole and using that as a scale the apparatus is probably no larger than about nine inches by twelve inches. Moreover, the apparatus is clearly defined as plastic. Such a statement might be true. However, the examiner is yet to see what is recited in claim 1 that prevents Whitfield from reading on it. For example does claim 1 preclude the underground water retention apparatus from **not being plastic**? The

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answer is no; therefore, claim 1 is anticipated by Whitfield. Does claim 1 preclude the underground water retention apparatus from **not being 9" by 12"**? The answer is no; therefore, claim 1 is anticipated by Whitfield. Applicant argues that Withfield does not define a structure that "resembles" his invention. While such a statement maybe true, there is nothing in the rejected claims that structurally define over the apparatus disclosed by Whitfield. Applicant argues that the corner posts (2) disclosed by Withfield cannot be considered as "perimeter support means". The examiner disagrees since top member (5) sits on posts (2) along its perimeter, therefore post (2) is considered as perimeter support means. Applicant argues that the walls (3) and the floor (6) of Withfield cannot be considered a liner means. The examiner disagrees in as much applicant's walls and floor are considered liner means (see Fig. 9 of applicant's drawings) then the walls (3) and floor (6) of Withfield are considered liner means. Applicant argues that the structure disclosed by Withfield amounts to a small plastic toy drain which is different from his invention. Once again the examiner would like to point out there is **nothing** in the rejected claims that structurally defines applicant's invention over the Withfield reference.

12. Applicant argues that claim 1 of his invention defines over Jordan et al. since Jordan et al. does not "resemble" it. Once again while such a statement maybe true, there is nothing in the rejected claims that structurally define over the apparatus disclosed by Jordan et al.. Applicant argues that members (90,92) of Jordan et al.

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cannot be considered as "perimeter support means". The examiner does not quite understand such statement since members (90,92) supports member (94) along its perimeter. Further, applicant argues that members (24,27-30) of Jordan et al. cannot be considered as "liner means" secured to perimeter support means. The examiner does not quite understand such statement since members (24,27-30) lines the cavity in the ground and is secured to the perimeter support means (90,92). Applicant argues that Jordan et al. teaches a home sewage system not a water retention system as his invention. The examiner would like to point out to applicant that home sewage does contain water and at some point it is retained within the structure defined by Jordan et al

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday 8:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

HEATHER SHACKELFORD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600



Sunil Singh

Patent Examiner
Art Unit 3673

SS SS
September 18, 2003